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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/784,139

02/20/2004

D. Peter Beime JR.

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08/28/2006

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EXAMINER

KENNEDY, JOSHUA T

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 08/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/784,139	BEIRNE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joshua T. Kennedy	3679	<i>Jtk</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/27/2006 has been entered.

Claims 1, 3-8, and 11-20 have been examined.

Claims 2, 9, and 10 have been cancelled.

### ***Drawings***

The drawings were received on 4/27/2006. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-8, and 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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It is unclear whether claims 1, 3-8, 11, and 13-20 are drawn to the combination or subcombination. In particular, the preamble of each of the claims 1, 11, and 20 imply the subcombination of the fall protection device while lines 11-13 in the body of the claim positively includes the roof. For this Office action only, it will be considered that these claims are drawn to the subcombination.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-8, and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pena (US Patent 5,820,497) in view of Willetts (US Patent 4,600,179).

As to Claims 1, 3, 7, 11-13, 17, 19, and 20. Pena discloses a fall protection device comprising:

at least one rail section having a plurality of vertical members (4) each having a lower end (9);

a plurality of horizontal members (13) connecting the vertical members;

a plurality of bearing feet (Figs 1 & 2) each having a connecting portion (5) and a bearing portion (6);

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wherein each bearing foot is secured to the lower end of one of said plurality of vertical members (Claim 1, Lines 3-6);

wherein the connecting portion (5) of the bearing foot is frusto-conical shaped;

wherein the frusto-conical shaped connecting portion engages the vertical member

wherein a first material forming the bearing portion having a first material hardness greater than a second material hardness of a second material forming the connecting portion (Col 3, Lines 33-39); and

However Pena does not disclose a bearing portion being disc shaped and being co-molded of polypropylene having a circular outer periphery having a lower edge being rounded, an upper surface, and a lower surface parallel with the upper surface and spaced from the upper surface; wherein the lower surface of the bearing portion being capable of resting on the roof and the lower end of the vertical member engages the upper surface of the bearing portion being capable of supporting the vertical member above the roof so that the vertical members do not engage the roof; and the connection portion being resiliently deformed to secure the bearing foot to the vertical member with an interference fit and resist removal of the bearing foot from the vertical member.

Willetts teaches a post to rail connection having a bearing portion being disc shaped (52) and being co-molded of polypropylene (Col 3, Line 14) having a circular outer periphery having a lower edge being rounded (Fig 9), an upper surface, and a lower surface parallel with the upper surface and spaced from the upper surface (Figs 5 and 6); wherein the lower surface of the bearing portion being capable of resting on the

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roof and the lower end of a vertical member is capable of engaging the upper surface of the bearing portion being capable of supporting the vertical member above the roof so that the vertical members do not engage the roof and a connection portion being resiliently deformed to secure the bearing foot to the vertical member with an interference fit and resist removal of the bearing foot from the vertical member and "to better seal against the entrance of moisture" (Col 3, Lines 23-24). It would have been obvious to one of ordinary skill in the art to modify the bearing foot of Pena to have a resilient connecting portion and a disc shaped bearing portion as taught by Willets "to tightly hold the rung and seal its aperture to block any entrance of water inside the rail" (Col 3, Lines 20-31).

Pena also does not disclose the tube being metal. However, does state "that numerous materials can be used" (Col 3, Lines 33-34) for the construction of the posts and rails and it is noted that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). It would have been obvious to one of ordinary skill in the art to modify the vertical posts of Pena to be metal to provide a sturdier frame.

As to Claim 4 and 14. Pena discloses each of the plurality of vertical members as in the form of a tube (Col 2, Line 67).

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As to Claims 5 and 15. Pena discloses each bearing foot having an axially extending passage formed therein which extends through both the bearing portion and the connecting portion and communicates an interior space of a tube with ambient space outside the tube so that any liquid that enters the tube flows out of the bottom of the tube through the passage in the bearing foot by gravity (Figs 1 & 2).

As to Claims 6 and 16. Pena discloses the connecting portion of the bearing foot extends into an open lower end of the tube (Figs 1 & 2) and resiliently engages an interior surface of the tube to secure the bearing foot thereto (Col 2, Lines 64-67; Col 3, Lines 1-11).

As to Claims 8 and 18. Pena in view of Willetts disclose the bearing portion having an upper surface and a lower surface spaced from the upper surface, but does not disclose the thickness of the bearing portion being at least 0.25 inches.

It is not inventive to state the optimum values of a thickness of the bearing portion. Although silent on the dimension, the device of Pena in view of Willetts inherently has a thickness relative to the size of the leg support. Through routine experimentation and optimization, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the leg support of Pena in view of Willetts to have the thickness of the bearing portion being at least 0.25 inches producing no new and unexpected results.

***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-8, 11-20 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua T. Kennedy whose telephone number is (571) 272-8297. The examiner can normally be reached on M-F: 7am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JTK  
8/17/2006



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